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ATTORNEY DOCKET NO. 10031291-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Nicolas J. Moll et al.

Serial No.: 10/766,639

Examiner: Daniels, Matthew J.

Filing Date: January 28, 2004

Group Art Unit: 1732

Title: NANOSTRUCTURES AND METHODS OF MAKING THE SAME

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☒ No additional fee (Address envelope to "Mail Stop Amendments")
☐ Other: (Fee \$_____)

| CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY | | | | | | |
|---|--|--|---|---|-------------|---------------------------|
| (1) FOR | (2) CLAIMS REMAINING AFTER AMENDMENT | (3) NUMBER EXTRA | (4) HIGHEST NUMBER PREVIOUSLY PAID FOR | (5) PRESENT EXTRA | (6) RATE | (7) ADDITIONAL FEES |
| TOTAL CLAIMS | | MINUS | | = 0 | X 50 | \$ 0 |
| INDEP. CLAIMS | | MINUS | | = 0 | X 200 | \$ 0 |
| <input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM | | | | | + 360 | \$ 0 |
| EXTENSION FEE | 1 ST MONTH 120.00 <input type="checkbox"/> | 2 ND MONTH 450.00 <input type="checkbox"/> | 3 RD MONTH 1020.00 <input type="checkbox"/> | 4 TH MONTH 1590.00 <input type="checkbox"/> | | \$ 0 |
| OTHER FEES | | | | | | \$ 0 |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | | \$ 0 |

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Nicolas J. Moll et al.

By

Edouard Garcia
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: May 25, 2005

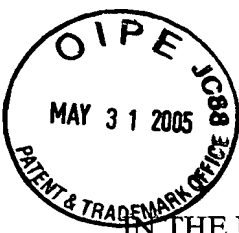
Typed Name: Edouard Garcia

Signature: _____

Reg. No. 38,461

Date: May 25, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Examiner's action dated April 29, 2005, Applicant provisionally elects with traverse the claims of Group I (claims 1-25). However, as explained in detail below, the restriction requirement is submitted to be improper (1) because the Examiner has failed to establish a *prima facie* case for restricting the claims, and (2) because no valid reason exists for dividing among the related inventions.

I. The Examiner has Failed to Establish a *Prima Facie* Case For Restricting the Claims

MPEP § 808.01 provides that inventions can be restricted if they are independent (i.e., unrelated). MPEP § 802.01 defines the term "independent" as follows (emphasis added):

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

The Examiner has based his requirement for restriction on his belief that the claims of Group I and Group II are unrelated. In particular, the Examiner has stated that:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are

CERTIFICATE OF MAILING

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Date

(Signature of person mailing papers)

Edouard Garcia

(Typed or printed name of person mailing papers)